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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,002	01/19/2006	Santiago Echeverri	2590-146	5148

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NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER

WISTERMAYER, ALEXIS M

ART UNIT	PAPER NUMBER
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3709

MAIL DATE	DELIVERY MODE
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10/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/565,002

Applicant(s)

ECHEVERRI, SANTIAGO

Examiner

Alexis M. Wistermayer

Art Unit

3709

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/19/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application.
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claims 1-12 are objected to because of the following informalities: In Claim 1, the period after "fixing" in Line 4 is not necessary. Appropriate correction is required.

Claim 6 is objected to because of the following informalities: In Claim 6 is objected to because of the following informalities: The "I" in "Instrument" (Line 2) should not be capitalized. Appropriate correction is required.

Claim 9 is objected to because of the following informalities: In Claim 9 is objected to because of the following informalities: The period after "positioner" (Line 3) is not necessary. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1, 2, 4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Bertin (US Pat 5700268).

Regarding Claim 1: Bertin teaches a guide/device comprising a shaft/top end (Figure 1 Element 50), instrument fixing means/cylinder (Figure 1 Element 45), a frame/separate driver (Figure 1 Element 11), pointing means/tapered portions (Figure 1 Elements 37 and 41) and orientation means/measuring device (Figure 3B Element 10).

Regarding Claim 2: Bertin teaches a guide/device where the pointing means comprise a pair of parallel shafts (Column 4 Lines 30 -40).

Regarding Claim 4: Bertin teaches a guide/device where said orientation means are adjustable (Column 5 Lines 30-55).

Regarding Claim 7: Bertin teaches a guide/device wherein said instrument fixing means are capable of a quick fixation or release (Figure 5 Element 45).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 3, 5,6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertin (US Pat 5700268) in view of Subba Rao (US Pat 6743235) as applied to Claim 1 above.

Regarding Claim 3: Bertin teaches a similarly claimed device as explained in the rejections above. Bertin does not teach a guide having a laser beam. Subba Rao teaches a guide/instrument having a laser beam (Figure 3). Bertin and Subba Rao are analogous art because they are from the same field of endeavor of hip replacement surgery devices. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use Subba Rao's laser beam in Bertin's device. The motivation would have been to offer a means for the surgeon to use accuracy and precision while performing the surgery without the burden of an additional tool being in the way.

Regarding Claim 5 and 6: Bertin teaches a similarly claimed device as explained in the rejections above. Bertin does not teach a guide having two bubble levels. Subba Rao teaches a guide/instrument having a bubble level. It is well known in the art that mere duplication of parts has no patentable significance unless a new and unexpected result is produced (See MPEP 2144.04 Section VI B). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use Subba Rao's bubble level and an additional bubble level in Bertin's device. The motivation would have been to offer a method of recognizing when the device was aligned correctly with improved accuracy to perform the hip surgery.

Regarding Claim 8: Bertin teaches a similarly claimed device as explained in the rejections above. Bertin does not teach a guide having an acetabular cup, a shaft with a handle, or a distal end adapted to receive a cup positioner. Subba Rao teaches a guide/instrument having an acetabular prosthetic cup instrument (Figure 1 Element 101), a shaft with a handle (Figure 1 Elements 22 and 24), and a distal end for receiving a reamer or cup positioner (Figure 5 Element 22). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use Subba Rao's elements in Bertin's device. The motivation would have been to offer an equivalent and alternative means of performing the hip surgery with the necessary tools connected to one instrument.

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertin (US Pat 5700268), in view of Lovell (US Pat 6395005) as applied to Claim 1 above.

Regarding Claim 9: Bertin teaches a similarly claimed device as explained in the rejections above. Bertin does not teach a guide having a pelvic positioner with two arms and two respective feelers. Lovell teaches a guide/apparatus with a pelvic positioner (Figure 2 Element 72) comprising two arms/locators (Figure 2 Elements 90 and 136) with respective feelers/ends (Figure 2 Elements 92 and 122). Bertin and Lovell are analogous art because they are from the same field of endeavor of hip replacement surgery and related devices. At the time of the invention, it would have been obvious to

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a person of ordinary skill in the art to use Lovell's elements in Bertin's guide. The motivation would have been to offer an equivalent and alternative means of performing the surgery with the necessary tools connected to one instrument.

Regarding Claim 10: Bertin teaches a similarly claimed device as explained in the rejections above. Bertin does not teach a guide having a pelvic orientation witness comprising pelvic fixing means. Lovell teaches a guide/apparatus with a pelvic orientation witness (instrument shown in Figure 2) comprising pelvic fixing means (Figure 2 Element 79). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use Lovell's pelvic orientation witness and fixing means in Bertin's device. The motivation would have been to offer an equivalent and alternative means of performing the surgery with the necessary tools connected to one instrument.

Regarding Claims 11 and 12: Bertin teaches a similarly claimed device as explained in the rejections above. Bertin does not teach a guide having an angle measuring device or a calibrating apparatus comprising angle reproducing means. Lovell teaches a guide/apparatus having an angle measuring device (Figure 4 and Column 3 Lines 5-50) and a calibrating apparatus (Figure 4 Elements 114 and 116 and Column 5 Lines 55-65). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use Lovell's angle measuring device and calibrating apparatus in Bertin's guide. The motivation would have been to offer an equivalent and alternative means of determining accurate angle measurements while performing the surgery with the necessary tools connected to one instrument.

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Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexis M. Wistermayer whose telephone number is 571-272-1197. The examiner can normally be reached on Monday - Friday 8 am - 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR)-system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMW 10/1/07


MARK EASHOO, PH.D.
SUPERVISORY PATENT EXAMINER

01/02/07